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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,509	09/28/2001	Kazuyoshi Kawasaki	Q64406	5657

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EXAMINER

WILSON, DONALD R

ART UNIT	PAPER NUMBER
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1713

12

DATE MAILED: 08/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-12

# Office Action Summary

Application No.

09/831,509

Applicant(s)

KAWASAKI ET AL.

Examiner

Donald R Wilson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-20 is/are pending in the application.
- 4a) Of the above claim(s) 4,5,8,9,13-17,19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,3,6,7,10-12 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

**Response to Amendment**

1. Applicant's amendment and declaration filed 6/20/03, have been fully considered with the following results.
2. The rejection of claims under 35 U.S.C. § 112, second paragraph, is overcome by the amendment and the rejection is withdrawn.
3. The amendment is not deemed to be persuasive in overcoming the rejections over the prior art which are maintained for reasons discussed below.

**Previously Cited Statutes**

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

**Claim Rejections - 35 USC § 102(b)/§ 103(a)**

5. **Claims 2-3, 6-7, 10-12 and 18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Logothetis, optionally in view of Imbalzano (for 103(a)).** The basis of this rejection was stated in Detailed Action § 14-16 of the previous Office Action.
6. Applicant traverses the rejection advising that “--- the carboxylic acid end group described in Logothetis is at most present at one chain end and almost all of such carboxylic acid groups are converted to salt.” This is not deemed to be persuasive because there is no evidence to support that the carboxylic acid end groups are present at only one chain end, and it ignores the specific teaching of carboxyl end groups as opposed to carboxylate group (col. 1, lines 55, to col. 2, line 13). As acknowledged by applicant the initiator results in formation of a carboxylic acid group at the beginning end of the polymer. Formation of the a carboxylic acid group would be expected to occur at the terminating end of the polymer chain as a result of hydrolysis of groups present due to chain transfer reactions or rearrangement of the PAVE radical at a growing chain end. This is presumably the same way in which the end groups at both ends result in the instant invention. (See for instance Imbalzano, col. 1, lines 41-63). Applicant relies on the teaching of Logothetis that in certain applications it may be

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desirable to remove the carboxyl and carboxylate end groups (col. 7, lines 9-27), presumably to argue that the reference is teaching against the presence of such groups. This is not deemed to be persuasive because as specifically stated by Logothetis, this is for "certain end-use applications", not all applications. The argument that "-- the carboxylic acid end group in Logothetis if contained has to be decarboxylated - --" is clearly not sustainable. Further, even if the absence of such groups were taught to be preferred, a reference is available for all that it teaches, not just preferred embodiments.

Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994).

7. In regards to Logothetis not focusing on the total amount of associated and non-associated carboxylic acid end groups, it is not necessary that the reference teach the same properties as used by applicant if such properties are inherent to the compositions taught and/or suggested therein. As has been previously pointed out, the burden is on applicant to show that the compositions do in fact differ.

It has been held that where applicant claims a composition in terms of function, property or characteristic where said function is not explicitly shown by the reference and where the examiner has explained why the function, property or characteristic is considered inherent in the prior art, it is appropriate for the examiner to make a rejection under both the applicable section of 35 USC 102 and 35 USC 103 such that the burden is placed upon the applicant to provide clear evidence that the respective compositions do in fact differ. *In re Best*, 195 USPQ 430, 433 (CCPA 1977); *In re Fitzgerald et al.*, 205 USPQ 594, 596 (CCPA 1980).

8. The statement that Logothetis is interested in carbonyl and not carboxylic acid groups is also not sustainable. As pointed out above, Logothetis specifically states a plurality of carbonyl-containing end groups selected from a group consisting of carboxyl endgroups, carboxylate endgroups, carboxamide endgroups and mixtures thereof (see sentence bridging columns 1 and 2). From this one of ordinary skill in the art would have clearly envisaged polymers with carboxyl end groups. Carboxyl end groups are known in the art to mean carboxylic acid end groups. (See for instance Hawley, p.223.)

9. Applicant traverses the optional added teaching of Imbalzano stating there is no motivation to combine Imbalzano with Logothetis, and further alleges that such a combination would not have been considered in view of the example 1 salt conversion of Logothetis. This is not deemed to be persuasive

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for reasons discussed above, i.e., Logothetis teaches compositions having carboxylic acid end groups, and the teachings of the prior art are not limited to working examples or preferred embodiments.

10. **Claims 2-3, 6-7, 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Buckmaster, Carlson or Gibbard.** The basis of this rejection was stated in Detailed Action § 17-20 of the previous Office Action.

11. Applicant traverses the rejection arguing that none of the references disclose a fluorine-containing elastomer having cross-linkable carboxylic groups. To support their argument applicant states that each of the cited references are melt fabricable fluoropolymers, not crosslinkable elastomers in accordance with Applicants' claims. This is not deemed to be persuasive because it is not necessary that the references teach that they are cross-linkable, which is an intended use. If the polymers are the same as applicants they would also be crosslinkable.

Intended use recitations and other types of functional language cannot be entirely disregarded. However, in apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963) (The claims were directed to a core member for hair curlers and a process of making a core member for hair curlers. Court held that the intended use of hair curling was of no significance to the structure and process of making.) See M.P.E.P. § 2111.03.

12. **Claims 12 and 18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Buckmaster, Carlson or Gibbard.** The basis of this rejection was stated in Detailed Action § 21-22 of the previous Office Action.

13. Applicant traverses the rejection relying on the same basis discussed above for the rejection of Claims 2-3, 6-7, 10-11, which is not deemed to be persuasive for reasons already discussed.

#### ***Art of Interest/Technological Background***

14. As pointed out in the previous Office Action, Marchionni discloses perfluoropolyether with acid fluoride end groups which are hydrolyzed to carboxyl groups and may be used in a future rejection of non-elected species of the instantly claimed invention.

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***Action Is Final***

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

16. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. This application contains Claims 4-5, 8-9, 13-17, 19 and 20 drawn to an invention nonelected with traverse in Paper No. 8. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Future Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald R Wilson whose telephone number is 703-308-2398.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 703-308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications. The unofficial direct fax phone number to the Examiner's desk is 703-872-9029.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-2351.

Donald R Wilson  
Primary Examiner  
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